REMARKS/COMMENTS:

The Applicant asks that the following amendments be entered respecting the Claims. These amendments are in response to the First Office Action, and are meant to overcome the Examiner's objections and place this application in condition for allowance.

1. Claim Rejections under 35 USC §112 regarding Claims 4-6 and 8-11.
   a. Claims 4, 6, 10, 11 have been canceled.
   Therefore, the rejections of them are made moot.
   b. Claims 5 is proposed amended, affecting dependent Claims 8 and 9.
   The Examiner believed that the phrase "the roughly flat underside" lacked antecedent basis. This phrase "roughly flat" has been eliminated in the attached proposed amendment of Claim 5, and "the underside" describes a part of "said footbed" which has antecedent basis in the claim.

2. Claim Rejections under 35 USC §102 regarding 1, 2, and 8-11.
   a. Claims 2, 10, and 11 have been canceled.
   Therefore, the rejections of them are made moot.
   b. Claims 8 and 9 (as dependant on Claims 1 and 5).
   The Examiner relies upon Fasse (US 4,843,672) for these rejections, saying that "Fasse shows an apparatus comprising a footbed made from resilient material and an attachment means at the front and the rear…."

   The §102 anticipation standard requires that a single reference teach each and every element of the application, expressly or inherently, to one of ordinary skill in the art.

   However, Fasse teaches away from the present disclosure in several critical ways.

First, the apparatus in *Fasse is not flat*, but thicker toward the front end of the footbed. (See Fasse, Claims 12 and 13; Figures 1, 4, 6, 7, and 8; and text Column 4, lines 37-60; Column 5, lines 8-11.) Fasse claims that this thickness must be between five and fifteen degrees from the horizontal (Column 2, lines 63 onward), so that it compensates for the forced angle of the ski boots, and makes walking easier than a flat footbed (See Fasse, Column 4, lines 37 through 60, and Figures 2A and 2B). Also, Fasse teaches only an oversole that has a ground contact surface that is shorter than the surface contacting the ski boot. This is not only antithetical to the present disclosure, but the present disclosure uses only a roughly flat footbed which extends the length of the ski boot's sole. This flatness is a stated advantage of the present disclosure, which makes the apparatus easier to carry when not in use, and eliminates extra material, which reduces production costs. (See, e.g., Specification paragraphs 0020, 0021, 0053)

The present disclosure requires that the footbeds be relatively flat, rather than bulky and thick. For example, the present footbed is not "wide," "heavy," or "bulky" like the prior art, but, rather, it is "relatively flat," "lightweight," and "relatively soft." (See, e.g., Specification paragraphs 0021, 0022.) The advantages of this relative flatness are discussed in the Specification. (See, e.g., paragraphs 0009, 0011.)

Second, Fasse is, essentially, a ski boot carrier, which exclusively teaches that the underside of the footbed have interlocking tabs or tongue-and-grove notches in its tread, so that the bottoms of the footbeds lock together when not in use. (See, e.g., Fasse, all Claims, 1-17; Figures 6, 7, and 8; and the text from Column 6, line 28 onward.)

Not only is this not a feature of the present disclosure, it is antithetical to the present disclosure in that *Fasse requires a tread and requires extra thickness in*

the tread on the underside of the footbed *to accomplish the locking of the two footbeds*. The present disclosure does not require a tread or this interlocking.

Third, Fasse teaches a one-size-fits-all footbed through the use of either of two *complicated means to shorten or lengthen the footbed which requires extra components*: either requiring a "tension spring" loaded "slider plate" or a "slider plate" plus a "locking pin." (See, e.g., Fasse, Claims 9, 10, and 11; Figures 1, 3, 4, and 5; and text from Column 5, line 40 onward, through to Column 6, lines 1-27.)

The present disclosure teaches away from such complexity, since the footbeds themselves can be manufactured to fit particular boots or made in standard sizes, thus greatly reducing manufacturing complexity and cost. (See, e.g., Specification paragraph 0051, and 0024.) The slider plate concept in Fasse adds numerous additional types of materials, as well as adding numerous additional parts. As such, Fasse teaches away from the present disclosure by solely teaching these additional complexities.

c. Claim 1 is amended.

The proposed amendment to Claim 1 has support in the Specification in the following locations, among others: paragraphs 0046 & 0047 (detailing pushing down on the clip, having it bend, and return to its original position); 0055 & 0056 (detailing how the footbed can be compressed/flexed and resiliently return to its original position); and 0057 (detailing the end members which engage the ends of the ski boots).

The primary reason Fasse is inapposite to the present disclosure was laid out in the prior section, and need not be repeated fully here: Fasse teaches only a bulky, wedge-shaped footbed, thicker toward its front end. It teaches away from the use of a flat footbed.

Secondly, Fasse teaches a footbed that is a single unit with its toe end attachment, rather than a separate member at the ski boot's toe end that provides attachment means. This is clearly illustrated in Figure 1, and labeled the "base 13" and "toe engagement flange 5."

Third, as discussed more fully in the prior section above, Fasse teaches a complicated means for attaching onto the rear of the boot. The present disclosure teaches simply a lip (or clip) that attaches over an end of a ski boot. (See, e.g., Specification, paragraph 0044; "heel cap 2" in Figures 1-3.) If the clip is placed at the front of the ski boot (as shown in the figures), then the lip can simply slide over the end of the ski boot. There is no need for a complicated "tension spring" loaded "slider plate" or a "slider plate" plus a "locking pin," as Fasse requires. As such, Fasse teaches away from the present disclosure.

3. Claim Rejections under 35 USC §103 regarding Claims 3-11.

a. Claims 3, 4, 6, 7, 10, and 11 have been canceled.

Therefore, rejections of them are made moot.

b. Claims 5, 8, and 9.

The proposed amendment to Claim 5 has support in the Specification in the following locations, among others: paragraphs 0053 ("relatively flat, elongated roughly rectangular piece"), 0055 ("The material can be compressed under pressure, and provide springiness and energy return while returning to its original shape.").

The Examiner relies upon Fasse (US 4,843,672), in view of Koniuk (US 4,619,059) for these rejections, saying that in addition to the elements of Fasse, Koniuk teaches a "bottom layer and tread from a resilient material."

The above arguments from the prior sections apply equally to these rejections. To the extent that Fasse teaches away from the present disclosure, the combination of

Fasse plus Koniuk also teaches away from the present disclosure. As such, the test for obviousness can not be met with this prior art.

It is important to note that *Koniuk teaches only a non-flat footbed.* (See, e.g., Koniuk, Column 3, lines 13-15, which discusses the rocking action of the "outwardly arcuate" underside of the footbed.) This makes it inapposite to the present disclosure in the same way as Fasse.

Secondly, *Koniuk teaches nothing about how the footbed attaches to the front* of the ski boot, mentioning merely a "locking toe 26" and a "front locking cap 26", without any further mention or labeling in the drawings. (See, e.g., column 3, lines 21, 25 and 27-30.) And the rear connection means is similarly vague, a "suitable strap means 24," from the figures. (See, e.g., column 3, line 21.) As such, it teaches almost nothing about connection means, other than to show a rear strap in the figures.

Third, Koniuk teaches only a footbed with "a resiliently deformable outer skin" over a less-dense core, a "more resilient deformable interior section." See, e.g., column 3, lines 39-45. (Note Koniuk's skin or core system is completely distinct from any attachment means.) Thus, *Koniuk teaches only a dual-density, skin-over-inner-core footbed*, rather than a one-piece flat footbed. This 'deformation' in Koniuk is so that it "conforms to irregular or inclined surfaces." As such, Koniuk does not teach the use of materials in a footbed that might provide springiness or aid in the stepping motion, like the present disclosure does. The materials in Koniuk only deform to rocks or hard edges, but do not add energy to the step.

Fourth, by the same token, since Koniuk teaches only a dual density footbed, the Applicant respectfully disagrees with the Examiner: Koniuk does not teach the addition of a tread on the bottom of the footbed. *The underside of Koniuk's*

footbed is without a tread. At best, the Koniuk figures show some waviness on the underside of the footbed, which is not mentioned or explained in its specification.

The combination of Koniuk with Fasse, if they are to support an obviousness rejection, must teach or suggest all the claim limitations. "[A] patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." *KSR International Co. v. Teleflex Inc.,* 550 US 398, 127 S.Ct. 30 (2007) (reaffirming the obviousness test from *Graham v. John Deere Co.,* 383 US 1 (1966)). Therefore, an obviousness determination requires "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness". *KSR*, quoting *In re Kahn*, 441 F.3d 977 (CA Fed. 2006). Restated, the Office must provide a clear, articulable, adequate "reason to combine" the references, through reasoning and/or analysis. 72 Fed. Reg. at 57528 (Oct. 10, 2007). Since required elements of Fasse and Koniuk specifically teach away from the present disclosure, adequate reason to combine the references can not be made in this case.

Even more important is that the present disclosure specifically solves problems created by the prior art of the likes of Fasse and Koniuk, including their more complex and expensive manufacture (because of their having more parts) and their bulkiness and difficulty in carrying them when not in use.

The Applicant respectfully asks that the Examiner enter the amendments contained herein, withdraw all applicable rejections and objections, and allow the remaining claims.

Thank you. Sincerely,

Ed Skoch